

This Opinion is Not a
Precedent of the TTAB

Mailed: August 16, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Brand3, Inc.

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Serial No. 90483463

Royal W. Craig of Gordon Feinblatt LLC,
for Brand3, Inc.

Edward Fennessy, Trademark Examining Attorney, Law Office 113,
Nicole Nguyen, Managing Attorney.

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Before Kuhlke, Lykos and Coggins,
Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

Brand3, Inc. (“Applicant”) seeks to register on the Principal Register the
composite mark displayed below (with BRANDS disclaimed)



for the following services:

Brand concept and brand development services for corporate and individual clients; Providing advertising and marketing consulting services to corporate and individual clients; Website traffic optimization for the websites of corporate and individual clients in International Class 35.¹

The description of the mark is as follows:

The mark consists of a thick horizontal line angled downward and outward at each end to form the silhouette of a flattop roof, below which appears the letters HPB in large bolded uppercase letters, below which appears the wording “HOMEPRO BRANDS” in uppercase lettering.

Registration was refused under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant’s mark so resembles the standard character mark HOMEPRO MATCH on the Supplemental Register for, in relevant part, the services identified below, that it is likely to cause confusion or mistake or to deceive:²

Business and consumer services, namely, providing a website promoting, advertising and marketing, via the website, third party vendors and suppliers, and services and goods of third party vendors and suppliers in the field of contracting and home improvement, namely, home and commercial property construction, maintenance, renovation and repair; providing via the website a searchable online directory to consumers searching third

¹ Application Serial No. 90483463, filed January 22, 2021 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on a bona fide intent to use the mark in commerce. The application also includes services in International Class 42 that are not subject to refusal.

Citations to the prosecution file refer to the USPTO’s Trademark Status & Document Retrieval (“TSDR”) system in .pdf format. Citations to briefs refer to the actual page number, if available, as well as TTABVUE, the Board’s online docketing system. The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

² Registration No. 6186884, registered on October 27, 2020.

party vendors and suppliers and goods and services of third party vendors and suppliers in International Class 35.

Applicant appealed and filed a request for reconsideration which was denied. The appeal is fully briefed. For the reasons explained below, we reverse the refusal to register.

I. Evidentiary Objection

At the outset, we address an evidentiary objection interposed by the Examining Attorney.

Applicant submitted with its October 12, 2022 Request for Reconsideration a listing of third-party registrations and applications.³ In his November 23, 2022 Denial of Applicant's Request for Reconsideration, the Examining Attorney timely objected on the ground that simply listing the registrations and applications does not make such registrations and applications of record.⁴ He further advised Applicant that in order to make the third-party registrations and applications part of the record, Applicant must submit copies or the complete electronic equivalent from the USPTO's automated systems.⁵ The Examining Attorney reiterates the objection in his brief.⁶

Applicant counters that the Examining Attorney's objection should be overruled because "that list was submitted to refute the credibility of the Examining Attorney's evidence presented in his Final Office Action of 12 April 2022" insofar as the twenty

³ October 12, 2022 Request for Reconsideration at TSDR 17-18.

⁴ November 23, 2022 Denial of Applicant's Request for Reconsideration at TSDR 10.

⁵ November 23, 2022 Denial of Applicant's Request for Reconsideration at TSDR 10.

⁶ Examining Attorney Appeal Brief, 9 TTABVUE 4.

(20) third-party registrations the Examining Attorney made of record to show relatedness of the Applicant's and Registrant's services did not constitute a "representative sample of the results of a search of the register" and are unrelated to the services at issue.⁷

We agree with the Examining Attorney that a mere listing is insufficient to make the referenced third-party registrations and applications of record. *See In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1405 n.17 (TTAB 2018) (citing *In re 1st USA Realty Prof'ls Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007)); *see also In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002) and TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 1208.02 (2023). Applicant was not only timely apprised that the third-party registrations and applications were not properly made of record but also advised as to the appropriate method for introducing this type of evidence. Applicant could have rectified its error by requesting remand, ideally prior to filing its brief, but failed to do. *See Trademark Rule 2.142(d)(1)*, 37 C.F.R. § 2.142(d) ("In an appeal from a refusal to register, if the appellant or the examining attorney desires to introduce additional evidence after an appeal is filed, the appellant or the examining attorney should submit a request to the Board to suspend the appeal and to remand the application for further examination."); *see also TBMP §§ 1207.01 and 1209.04.*

⁷ Applicant's Reply Brief, 10 TTABVUE 4.

Accordingly, we sustain the objection and give no consideration to the listing.⁸

II. Likelihood of Confusion – Applicable Law

We now direct our attention to the substantive refusal before us. Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”), cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 113 USPQ2d 2045, 2049 (2015). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor for which there is evidence or argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). “Whether a likelihood of confusion exists between an applicant’s mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018).

In general, two key considerations are the similarities between the marks and the similarities between the services, the first and second *DuPont* factors. *See In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *see also In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-

⁸ We hasten to add that third-party applications have no probative value other than as evidence that the applications were filed. *See In re Team Jesus LLC*, 2020 USPQ2d 11489, at *3 n.29 (TTAB 2020) (“an application would be evidence only of the fact that it was filed, and therefore has no probative value”).

46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the [services] and differences in the marks.”). However, “[e]ach case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011). Such is the case here.

A. Scope of Protection of the Cited Mark

We commence with the scope of protection of the cited mark HOMEPRO MATCH. “[T]he strength of a mark is not a binary factor” and “varies along a spectrum from very strong to very weak.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675-76 (Fed. Cir. 2015) (internal citations omitted). “The weaker [the cited] mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.” *Id.* at 1676 (internal citations omitted).

A critical component of the strength of a cited mark is its inherent or conceptual strength based on the nature of the mark itself. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength ... and its marketplace strength”); *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength

of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006).⁹ “Conceptual strength is a measure of a mark’s distinctiveness, and distinctiveness is often classified in categories of generally increasing distinctiveness[:] . . . (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 112 S. Ct. 2753, 120 L. Ed. 2d 615 (1992). Merely descriptive and highly suggestive marks may be entitled to a narrower scope of protection than an entirely arbitrary or coined word. *See, e.g., Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (citing *Juice Generation*, 115 USPQ2d at 1674); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005)); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1026 (TTAB 2009); *In re Box Sol’ns Corp.*, 79 USPQ2d 1953, 1957-58 (TTAB 2006).

The cited mark HOMEPRO MATCH is registered on the Supplemental Register, meaning that it is capable of becoming a source indicator and registrable on the Principal Register only upon demonstrating acquired distinctiveness under Trademark Act Section 2(f). *See In re The Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 340-41 (CCPA 1978). It is well established that a mark registered on the

⁹ We do not have evidence in the record of commercial strength, i.e. “the marketplace recognition value of the mark.” 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:80 (5th ed. 2023). Commercial strength is a question of “whether consumers in fact associate the . . . mark with a unique source.” *Id.*

Supplemental Register constitutes “a mark registered in the Patent Office” under Section 2(d) of the statute and may be cited as a bar to registration under Trademark Act Section 2(d). *Id.* at 340; *Hess v. Helene Curtis Indus., Inc.*, 94 USPQ 11 (Comm’r. 1952). However, the scope of protection of a mark on the Supplemental Register is more limited since it falls on the weaker end of the spectrum. As explained by the Board in *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975) (cited in TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1207.01(b)(ix) (July 2022)):

[R]egistration on the Supplemental Register may be considered to establish prima facie that, at least at the time of registration, the registered mark possessed a merely descriptive significance. This is significant because it is well established that the scope of protection afforded a merely descriptive or even a highly suggestive term is less than that accorded an arbitrary or coined mark. That is, terms falling within the former category have been generally categorized as “weak” marks, and **the scope of protection extended to these marks has been limited to the substantially identical notation and/or to the subsequent use and registration thereof for substantially similar goods.**

Emphasis added. *Accord In re Central Soya Co., Inc.*, 220 USPQ 914, 917 (TTAB 1984) (Board reiterated that “the scope of protection extended to these [descriptive] marks [registered on the Supplemental Register] has been limited to the substantially identical notation ... for substantially similar goods” in reversing Section 2(d) refusal to register POSADA on the Principal Register for Mexican style prepared frozen enchiladas based on the cited mark LA POSADA on the Supplemental Register for lodging and restaurant services); *In re Tex, Instruments Inc.*, 193 USPQ 678, 679-80 (TTAB 1976) (registration of COPPERCLAD on the Supplemental Register for copper

coated electrodes did not bar registration of COPPER CLAD on the Principal Register for copper wire under Section 2(d)).

The guidance set forth in *Hunke & Jochheim* is consistent with the precedent of the U.S. Court of Appeals for the Federal Circuit affording marks on the Supplemental Register a more limited scope of protection. For example, in *In re The Clorox Co.*, the Court affirmed a Section 2(d) refusal based on a cited mark on the Supplemental Register only because the goods were identical (stain removers), and also because the marks “ERASE and ERASER [were] virtually indistinguishable and the addition of the descriptive word STAIN to ERASER [was] insufficient to distinguish between the marks as a whole and to avoid confusion.” *Clorox*, 198 USPQ at 341. Likewise, the Court affirmed a Section 2(d) refusal to register the mark ROPELOK on the Principal Register based on the cited registration of ROPELOCK on the Supplemental Register because the marks were almost identical and the identified goods consisted of “closely related safety equipment.” *In re Rsch. Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986).

Here, the record is devoid of evidence to suggest that the cited mark acquired distinctiveness subsequent to its registration on the Supplemental Register. Thus, in the case at hand, we can presume the registration on the Supplemental Register of the cited mark HOMEPRO MATCH renders the mark as a whole conceptually weak, such that the public will look to other elements to distinguish the source of the services. *See Juice Generation*, 115 USPQ2d at 1674-75.

B. The Marks

With the above guidance in mind, we now compare Applicant's composite mark



with Registrant's standard character mark HOMEPRO MATCH in terms of appearance, sound, connotation and commercial impression under the first *DuPont* factor. *Palm Bay Imps.*, 73 USPQ2d at 1692 (citing *DuPont*, 177 USPQ at 567).

Both marks share the conceptually weak term HOMEPRO, but the similarities stop there. The other element consumers will take note of in Applicant's mark is its dominant element, the apparently arbitrary acronym HPB. HPB appears center and above HOMEPRO BRAND in a much larger sans serif block font such that the wording HOMEPRO BRAND is much less dominant. For this reason, the boldness of HPB not only dominates Applicant's mark but also distinguishes it from the cited mark. As such, the marks are more dissimilar than similar overall in appearance, sound, connotation and commercial impression. *See Jack Wolfskin*, 116 USPQ2d at 1134 (acknowledging the fundamental rule that the marks must be considered in their entireties). In other words, the marks are not "substantially similar," *see Hunke & Jochheim*, 185 USPQ at 189, and consumers will readily distinguish Applicant's mark with Registrant's mark.

The first *DuPont* factor therefore weighs against a finding of likelihood of confusion.

C. The Services

This brings us to the second *DuPont* factor which requires us to determine the similarity or dissimilarity of the services as recited in the application and in the cited registration. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018); *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See also B&B Hardware*, 113 USPQ2d at 2049 (recognizing that an “applicant’s right to register must be made on the basis of the goods described in the application”).

Based on the language of the identifications alone, we find that the services are in-part legally identical. Applicant’s “Providing advertising and marketing consulting services to corporate and individual clients” is unrestricted as to any particular industry or platform. These services are therefore sufficiently broad to encompass Registrant’s more narrowly tailored “Business and consumer services, namely, providing a website promoting, advertising and marketing, via the website, third party vendors and suppliers, and services and goods of third party vendors and suppliers in the field of contracting and home improvement, namely, home and commercial property construction, maintenance, renovation and repair.” *See Southwestern Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015), *aff’d*, 652 F. App’x 971 (Fed. Cir. 2016) (given broad identification of services, “we must presume that the services encompass all services of the type identified”). As

such, the services are in-part legally identical. And even if not legally identical, there is sufficient evidence in the form of third-party registrations and third-party uses to show that the services are in-part related.¹⁰ Hence the services are closely related if not identical.

Accordingly, the second *DuPont* factor weighs in favor of finding a likelihood of confusion.

D. Balancing the *DuPont* Factors

“No mechanical rule determines likelihood of confusion, and each case requires weighing of the facts and circumstances of the particular mark.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010).

Keeping in mind the relative weakness of the cited mark HOMEPRO MATCH registered on the Supplemental Register, the marks are so dissimilar overall in appearance, sound, connotation, and commercial impression so as to outweigh the in-part identical or closely related nature of the services. *See Kellogg Co. v. Pack'em Enters., Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *DuPont* factor may not be dispositive.”). We therefore find confusion to be unlikely.

In re Hunke & Jochheim, supra, cautioned against expanding the scope of protection of marks registered on the Supplemental Register beyond marks that are

¹⁰ See April 12, 2022 Office Action and November 23, 2022 Denial of Applicant’s Request for Reconsideration.

“substantially identical” and/or services that are “substantially similar.” There are rational reasons for this holding:

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

Hunke & Jocheim, 185 USPQ at 189 (quoting *Sure-Fit Prods. Co. v. Saltzson Drapery Co.*, 117 USPQ 295, 297 (CCPA 1958)).

To be clear, we are not suggesting that a different likelihood of confusion standard applies to cited marks on the Supplemental Register. Rather, we are acknowledging that the scope of protection may be more limited.

Decision: The Section 2(d) refusal to register Applicant’s mark is reversed.